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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/558,465 04/25/00 DUNLOP

D 7546M

EXAMINER

HM12/0511

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ART UNIT

PAPER NUMBER

1615

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/558,465

Applicant(s)

DUNLOP ET AL.

Examiner

P. E. McQueeney

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4&5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Acknowledgement is made of applicants' response to notice to file missing parts filed July 20, 2000, information disclosure statement filed July 20, 2000 and supplemental information disclosure statement filed October 25, 2000.

#### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-34 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-25 of copending Application No. 09/558,447 and claims 1-23 of copending Application No. 09/558,466. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-34 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-25 of copending Application No. 09/558,447 and claims 1-23 of copending Application No. 09/558,466. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: all three applications claim the same antidandruff shampoo composition. The only difference between the applications is the manner in which applicants list the ingredients. The '447 application requires 6 ingredients in the independent claim. The '466 application only requires 5 ingredients in the independent claim and makes the 6<sup>th</sup> ingredient of the '447 application a dependent claim therefrom. The present application includes the exact same ingredients as the '466 application in the independent claim also including the 6<sup>th</sup> ingredient of the present application as a dependent claim.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 112***

4. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12, applicants claim that the "non-volatile conditioning agent comprises dispersed, silicone." Applicants disclose at page 9 of the specification to page 17 of the specification a variety of silicone compounds, including silicone oils, cationic silicones, silicone gums, high refractive index silicones and silicone resins. Applicants do not specifically disclose what compounds fall into the "dispersed, silicon" classification. As applicants have provided no definition for "dispersed, silicon," and the specification teaches a wide variety of silicone compounds, examiner has interpreted this term broadly in the action that follows. Clarification is requested.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-9, 12-14, 16, 18-20, 30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Ramachandran *et al.* (WO 96/29983). Ramachandran *et al.*

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disclose mild aqueous detergent, e.g. shampoo, composition comprising anionic surfactants. Ramachandran *et al.* disclose in claim 1 "a mild aqueous detergent composition ... comprising: (a) from about 4 to about 12% by weight of an anionic surfactant ...; (c) about 0.3 to 7% by weight of a long-chain alcohol or ethoxylated alcohol averaging about 26 to 40 carbon atoms as a suspending and conditioning agent; (d) an effective amount of a therapeutic agent selected from the group consisting of .....(ketoconazole),... zinc pyrithione, ... coal tar,... and mixtures thereof; and (e) about 50 to 85% by weight of water." Ramachandran *et al.* claim in claim 10 that the composition further contains a hair conditioning agent "selected from the group consisting of organosilicone compounds, aminosilicones, water insoluble hydrocarbons, ... and mixtures thereof, present at a level of from about 0.2 to 5% by weight." Ramachandran *et al.* disclose, at page 10, lines 4-32, specific hair conditioning agents, including guar hydroxypropyl trimethylammonium chloride. These claims and disclosure read directly on applicants' claims 1-9, 12-14, 16, 18-20, 30 and 32.

6. Claims 1-12, 18-29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Guskey (US 5,977,036).

Guskey claims, in claim 1, a styling shampoo composition comprising:

(a) from about 5% to about 50% by weight of a deterative surfactant selected from the group consisting of anionic surfactants, zwitterionic or amphoteric surfactants, and combinations thereof;

(b) from about 0.025% to about 3% by weight of an organic cationic deposition polymer which has a cationic charge density of from about 0.2 meq/gm to about 7 meq/gm and an average molecular weight of from about 5,000 to about 10 million selected from the group consisting of cationic cellulose derivatives, cationic starch derivatives, cationic guar derivatives and mixtures thereof;

(c) from about 0.1% to about 10% by weight of a water-insoluble hair styling polymer selected from the group consisting of silicon grafted polymers, organic polymers comprising one or more polymerizable hydrophobic monomers, and mixtures thereof;

(d) from about 0.1% to about 10% by weight of a volatile, water-insoluble carrier for the hair styling polymer selected from the group consisting of hydrocarbons, ethers, esters, amines and alcohols;

(e) from about 0.005% to about 2.0% by weight of a crystalline hydroxyl-containing stabilizing agent having the formula ...; and

(f) from about 25.0% to about 94.8% by weight water.

This claim reads on applicants' claims 1-9, 12, 18, 19, 21-23, 25, 26 and 30. Guskey claims, in claim 5, that the cationic cellulose derivative is polyquaternium-10 and the cationic guar derivative is guar hydroxypropyltrimonium chloride. This claim reads on applicants' claims 20 and 24. Guskey claims, in claim 10, that her composition "further comprises from about 0.025% to about 1.5% of a polyalkylene glycol, wherein said polyalkylene glycol is characterized by the general formula: ... wherein R is hydrogen, methyl or mixtures thereof, and n is an integer having an average value of

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from about 1,500 to about 25,000. This claim reads on applicants' claims 27-29.

Guskey discloses, at col. 26, lines 10-65, that her composition can include from about 0.1% to about 5.0% suspending agents, such as ethylene glycol distearate (see particularly line 36). This disclosure reads on applicants' claims 10 and 11. Guskey discloses at col. 17, lines 37-50 that her composition can include about 0.001% to about 10% by weight of anti dandruff agents.

These claims and this disclosure meet the limitations of applicants' claims 1-12 and 18-29.

Guskey discloses, at col. 27, lines 1-20, the method of using her composition. This method includes a) wetting the hair, b) applying an effective amount of the shampoo composition to the hair, c) shampooing the hair with the composition, and d) rinsing the composition from the hair with water. This disclosure reads directly on applicants' claim 31.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:



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1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 1-9, 12-14, 16, 18-20, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramachandran *et al.*

As discussed above, Ramachandran *et al.* discloses the composition of applicants' claims 1-9, 12-14, 16, 18-20, 30 and 32. Ramachandran *et al.* does not explicitly disclose the bioavailability/coverage index, the conditioning index value, or the minimal inhibitory concentration index value of her composition. Since Ramachandran *et al.* teaches the applicants' instant composition, it is deemed that the bioavailability/coverage index, the conditioning index value, and the minimal inhibitory concentration index value of applicants' claims 1-9, 12-14, 16, 18-20, 30 and 32 and are implicit in the teachings of the reference.

8. Claims 1-12, 18-29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Guskey.

As discussed above, Guskey discloses the composition of applicants' claims 1-12 and 18-29 and the method of applicants' claim 31. Guskey does not explicitly disclose the bioavailability/coverage index, the conditioning index value, or the minimal inhibitory concentration index value of her composition. Since Guskey teaches the applicants' instant composition, it is deemed that the bioavailability/coverage index, the

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conditioning index value, and the minimal inhibitory concentration index value of applicants' claims 1-9 and 30 and are implicit in the teachings of the reference.

9. Claims 1-13 and 15-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guskey and Cardin *et al.* (US 5,104,645).

As discussed above, Guskey discloses the composition of applicants' claims 1-12 and 18-29 and the method of applicants' claim 31. Guskey does not disclose that the anti dandruff agent can be the zinc salt of 1-hydroxy-2-pyridinethione (applicants' claims 13 and 30).

Cardin *et al.* disclose antidandruff shampoos. Cardin *et al.* disclose that when the platelet form of a pyridinethione metal salt with a specified particle size is combined with any of a group of specific synergizers in a shampoo matrix that an unexpected substantial improvement in antidandruff efficacy is realized (col. 1, lines 37-45). Cardin *et al.* disclose that the antidandruff active is 1-hydroxy-2-pyridinethione salt in platelet particle form having an average particle size from 2  $\mu\text{m}$  to about 15  $\mu\text{m}$  (col. 5, lines 54-58). Cardin *et al.* disclose that it is preferential to use approximately 0.3% to about 2% of the pyridinethione metal salt (col. 5, lines 58-60). Cardin *et al.* discloses that the preferred salt is zinc (col. 6, lines 24-25). Cardin *et al.* disclose that the synergizers include polyethylene glycols.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the antidandruff of Cardin *et al.* in the teachings of Guskey because Guskey teaches that her shampoo composition can include

antidandruff agents and Cardin *et al.* teach that 1-hydroxy-2-pyridithione can be used as an antidandruff agent in shampoos comprising polyethylene glycols. The expected result would be an antidandruff composition that exhibits increased efficacy.

Guskey and Cardin *et al.* do not explicitly include a hair growth regulating agent in their composition. It is the position of the examiner that, absent a showing of criticality, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include other beneficial hair ingredients, such as coal tar, minoxidil, etc., in the teachings of Guskey and Cardin *et al.* in order to provide additional beneficial agents to the hair. The expected result would be a multi performance hair care product.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. E. McQueeney whose telephone number is 703-306-5827. The examiner can normally be reached on M, T, H, F 7:45 AM to 6:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3592 for regular communications and 703-308-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

THURMAN K. PAGE  
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